

## **REMARKS/ARGUMENTS**

This paper responds to the Office Action of November 3, 2003, as amended by the Examiner's Summary of January 22, 2004. The shortened statutory period is extended to run through May 3, 2004. Accordingly, this response is timely.

Applicant respectfully requests reconsideration of the application. Claims 1-118 are now pending, a total of 118 claims. Claims 1, 2, 28, 31, 53, 56, 60, 74, 93 and 102 are independent.

Applicant requests confirmation that the amendments to the specification requested in the paper of March 31, 2003 have been entered.

### **I. Status of the Application**

Applicant requests confirmation that the amendments to the specification requested in the paper of March 31, 2003 have been entered.

Applicant encloses a copy of an Information Disclosure Statement and Form 1449 filed April 29, 2003 and again on June 3, 2003. No checked-off copy of this Form 1449 has been received. Applicant requests consideration of the documents that were filed April 29, 2003 and June 3, 2003.

Applicant filed a Change of Correspondence Address on October 13, 2003. However, the Interview Summary of January 22, 2004 was mailed to the old address, resulting in considerable delay. A second request for Change of Correspondence Address is included herewith. Applicant requests confirmation that the correspondence address (the same address as appears at the foot of this paper) is now entered in the PTO's records.

Applicant thanks Examiners Sough and Kanof for a telephonic interview of January 6, 2004. The Examiner's Interview Summary of January 22, 2004 does not accurately reflect the agreements reached in that interview. A corrected statement is set out in the Interview Summary filed on April 21, 2004, and below.

## II. Section 101 Issues

Even though no § 101 rejection was properly raised<sup>1</sup>, Applicant has amended the claims to moot the § 101 issue.

## III. Section 112 ¶ 2 issues

The Interview Summary of January 22 states that Applicant agreed to amend the claims for § 112 ¶ 2 definiteness. This is not correct. Instead, the Examiners requested a showing of definiteness in Applicant's next paper. That showing appears below.

A claim may be defined by its relationship to its environment. In the interview, Applicant pointed to *Orthokinetics Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986), which is cited in the MPEP. *Orthokinetics* discusses a claim directed to a wheelchair “so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats.” Applicant noted that this wheelchair would infringe when inserted into a large car, but not infringe when blocked from insertion into a small car. Because claim scope is clear in each circumstance, the *Orthokinetics* claim was definite. Here, the Office Action raises no question of difficulty of determining claim scope; it merely notes that infringement may depend on the environment. *Orthokinetics* makes clear that this is simply irrelevant to § 112 ¶ 2.

MPEP § 2173.05(a) instructs that “if the language is as precise as the subject matter permits, the statute ... demands no more.” In the Interview, Applicant requested any suggestion the Examiners might offer for language that might “improve the clarity or precision” of the claims without changing their scope; the Examiners were unable to offer any such suggestion. If

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<sup>1</sup> The Office Action raises § 101 issues, because certain claims have “no connection to the technological arts.” This is not the test under § 101. Instead, the test is whether the invention produces a “useful, concrete and tangible result.” *AT&T Corp. v. Excel Communications Inc.*, 172 F.3d 1352, 1355-61, 50 USPQ2d 1447, 1451-54 (Fed. Cir. 1999) (stating that a number of prior tests are no longer applicable – the only valid test is “useful, concrete and tangible result”); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1374, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998).

*Ex parte Bowman*, 61 USPQ2d 1669 (Bd. Pat. App. & Interf. 2001) is not binding precedent (see page 1670, “The Board of Patent Appeals and Interferences has indicated that this decision was not written for publication, and is not binding precedent of the Board.”) and may not be relied upon where it conflicts with Federal Circuit precedent.

there is no language that is more precise, Applicant suggests that the claims are “as definite as the subject matter permits,” and meet the requirements of § 112 ¶ 2.

#### **IV. Prior art issues**

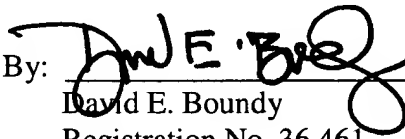
All prior art issues are discussed in Applicant’s paper of Response of March 31, 2003. The last two Office Actions have omitted all consideration of those remarks. Applicant is unable to advance prosecution further until some answer to those remarks is provided. MPEP § 707.07(f) (examiner must “Answer All Material Traversed”). A brief summary of the open issues appears in the Interview Summary filed on April 21, 2004. Applicant requests full consideration of the Remarks presented March 31, 2003.

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. Enclosed is Petition for Extension of Time for two months. In the event that further extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114595-02.

Respectfully submitted,

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Dated: April 30, 2004

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